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Response to Office Action Dated 08/27/2003

REMARKS

In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the subject application. This amendment is believed to be fully responsive to all issues raised in the 08/27/2003 Office Action.

Claims Amendments

No claims are currently amended by this Response. Claims 16—30, 46—60 and 76—90 were cancelled without prejudicing the Applicant's right to reinstate or re-file the same or similar claims. Claims 91—109 are newly added.

The Kim Reference

The Kim Reference teaches a browser adapted to put advertisements onto the screen. In particular, Kim teaches an application which runs as part of, or in conjunction with, a browser program. The application periodically downloads advertisements (ads) when the browser is substantially idle and stores them locally (Abstract; lines 4—7). Kim detects transition from a first web page to a second web page, and takes advantage of the time during which it takes the second webpage to download (0045; lines 1—2) to display (0077; lines 5—10) the locally stored ads. Note that the ad may occupy the full window of the browser (0078; lines 2—5), a partial window, or may be positioned outside the window (0078; lines 10—13).

Therefore, Kim teaches browser technology configured *for the display of ads*, either in the full browser window, a part of the browser window or in a new window. The ads are displayed in response to a change from the first webpage to the second webpage. However—as the Office Action points out and the Applicant agrees—Kim does not disclose ignoring requests for a second window where the request was not initiated in response to user action.

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The "How-To" Reference

In contrast to the browser software seen in Kim, the How-To reference teaches an enhancement to software which configures a website. As such, the How-To reference discloses sending code to browsers which influences whether requests (inserted by the website's host) to open a second browser window actually result in opening of a second window.

In particular, the How-To reference discloses a strategy to prevent display of advertisements which the host server of the website inserts on pages sent by the website upon request of a (typically remotely located) browser. Accordingly, the How-To reference does not disclose browser technology which ignores or follows instructions for opening a second window. Instead, How-To discloses website software which sends code to prevent the opening of second windows. Such code causes instructions calling for a second window to be turned into ineffective comments or causes any second window which is opened to be immediately closed.

Rejection Under Section 103

Claims 1—90 were rejected under 35 U.S.C. section 103(a) as being anticipated by U.S. application 2002/0052925 ("Kim") and the How-To document (How-To). Applicant has canceled claims 16—30, 46—60 and 76—90, so the rejection is now moot as to those claims. With respect to claims 1—15, 31—45 and 61—75, Applicant respectfully traverses the rejection.

In particular, independent claims 1, 31 and 61 define a method, browser and system, respectively, wherein a request to open a second browser window is received, and wherein the request is ignored if the request was not initiated by a user action and granted if the request was initiated in response to a user action.

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1 The Office notes, and the Applicant agrees, that *Kim fails to disclose*
2 *ignoring the requests if the request was not initiated in response to user action.*
3 However, the Office suggests that the How-To document discloses "ignoring the
4 request if the request was not initiated in response to a user action." The
5 Applicant respectfully disagrees.

6 The Office was forced to attempt to find an example of "ignoring the
7 request if the request was not initiated in response to a user action" *since Kim does*
8 *the opposite*—i.e., Kim discloses and promotes the putting up of ads—either in
9 existing or new second windows—wherein the request generating the ad (and
10 second window) was "not initiated in response to a user action." In other words,
11 Kim gives the web-surfer ads they didn't ask for, *and this is the core of the Kim*
12 *reference.* For example, under the teachings of the Kim reference, if a user asks
13 for a second page (e.g. clicks a link) then before the user gets that second page, the
14 user gets an ad—either in the existing window or a new second window. (See
15 0078 and many other locations.) Thus, Kim teaches away from the idea of
16 ignoring second window requests not initiated in response to user action, and
17 instead teaches putting up second windows with ads not requested by user action.
18 This is not incidental to Kim's teachings; generating and fulfilling second window
19 requests not in response to user action is the absolute core of the teachings of the
20 Kim reference. *Accordingly, since it is at the core of Kim's teachings to put up*
21 *second windows, and not to ignore requests for second windows not initiated in*
22 *response to user action, Kim teaches away from any reference (if one exists) which*
23 *ignores "the request (to open a second window) if the request was not initiated in*
24 *response to a user action".*
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1 The Kim and How-To references vigorously teach away from each other.
2 Kim is focused on providing advertisements to the web-surfer during the interval
3 between first and second web-pages the web-surfer intended to visit. How-To is
4 focused on preventing advertisements inserted by a website host. Thus, the two
5 references teach away from each other because they have different—almost
6 opposite—goals, i.e. preventing ads vs. providing ads. Moreover, the two
7 references teach away from each other due to their different approaches. That is,
8 Kim teaches a modification to a browser on a web-surfing client (which impacts
9 the experience of one web-surfer on many websites), and How-To teaches
10 modification of a website (which impacts the experience of many web-surfers on
11 one website). Such profound differences in approach and goals reinforce the view
12 that the references vigorously teach away each other.

13 The references additionally teach away from each other, in part, because
14 they cannot be combined into a workable system. As seen above, Kim loads an ad
15 into a (first or newly-opened second) window in response to a request not initiated
16 in response to user action. To disable this functionality from Kim, and to replace
17 it with the ad-stopping teachings of How-To (if this is possible), would completely
18 gut the functionality of the Kim reference. Kim would no longer deliver any ads,
19 which is Kim's only focus. Similarly, How-To would be unable to function within
20 a browser environment, since How-To functions by modifying the data/software
21 sent by a website from a website host, wherein the modifications are made
22 according to the particulars of the website host. That is, How-To teaches a variety
23 of modifications which may be made to a given website according to the particular
24 operation of the website's host. However, How-To does not disclose adaptations
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1 for a browser configured to move from website to website hosted by different
2 servers.

3 Thus, Kim and How-To cannot be combined in a logical manner. The core
4 of Kim's teachings is to operate on a browser (an Internet client) to display ads—
5 not in response to user request—while the user is waiting for the web page that
6 they did request. The core of How-To's teaching is to operate on a website (i.e. an
7 Internet host) to squelch ads which were not requested by the user. If they were
8 combined, it is unclear if they would operate on server or client or if they would
9 display or reject ads. It is important to note that How-To's technology cannot
10 operate on a browser, since How-To must be configured to each website according
11 to the ad-injection strategy of the host. (See, for example, all of How-To's
12 strategies, each aimed to counter a different server ad-injection strategy.) Thus,
13 How-To does not teach technology that may be adapted for use with a browser
14 (such as Kim's browser) which surfs from host to host, each of which might have
15 different ad-injection strategies. Kim cannot be operated on the website, since it
16 depends on downloading ads during slow periods, and then having a local
17 presence on the user's machine (for reasons of speed, etc.) to quickly put up ads
18 for brief periods. Thus, these two references—one intended to promote ads and
19 one intended to restrict ads—cannot be reasonably combined.

20 Additionally, neither Kim nor How-To disclose evaluating "if the request"
21 was or was not initiated in response to a user action, as is expressly recited in the
22 claims. For example, paragraphs 2 and 3 in claim 1 reflect different evaluations of
23 whether the request was or was not initiated in response to a user action. In
24 particular, Kim loads an ad into the first window, or opens a second window and
25 loads an ad into it, wherein the ad-loading is not in response to user action. How-

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1 To attempts to modify website code to counteract any ads that the server/host may
2 have tried to slip in. Accordingly, a combination of the two references would fail
3 to evaluate "if the request was" initiated "in response to a user action."
4 Accordingly, even when combined, the references of record do not teach this the
5 elements recited in the claims.

6 And still further, How-To does not actually ignore requests for second
7 windows, since How-To is server or website software, which does not actually
8 receive any requests to open windows on the browser. Instead, How-To prevents
9 generation of, or countermands, second window requests, rather than teaches
10 ignoring them. In particular, most of How-To's strategies involve turning second
11 window commands into comments—as opposed to receiving second window
12 commands and ignoring those commands.

13 **Claims 2—15, 32—45 and 62—75**

14 These claims are allowable due to their dependency on claims which are
15 allowable for the reasons seen above, as well as for reasons associated with the
16 elements recited in each claim.

17 **New claims 91—105**

18 New claims 91—105 are allowable for at least the same reasons claims 1—
19 15, 31—45, and 61—75 are allowable. In particular, independent claim 91 is
20 allowable for at least the same reasons claims 1, 31 and 61 are allowable, as
21 discussed above.

22 **New claims 106—109**

23 New claims 106—109 are allowable as being dependent on claims
24 allowable for the reasons seen above, as well as for reasons associated with the
25 elements recited in each claim. In particular, claims 106—109 recite an example

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1 of how "in response to user action" and "not in response to user action" can be
2 determined. Neither Kim nor How-To evaluate "if the request" was or was not
3 initiated "in response to a user action." Accordingly, neither Kim nor How-To
4 disclose the elements recited in claims 106—109, which are allowable for at least
5 this reason.

6 Conclusion

7 As noted by the Office, the Kim reference does not disclose ignoring
8 requests for a second window if the request was not initiated in response to user
9 action. As noted by the Applicant, the *core* of Kim's teaching is actually to open
10 second windows not in response to a user action to display an ad. Moreover, the
11 How-To reference discloses strategies to prevent opening of a second window all
12 of the time, *as opposed to not in response to user action*. How-To is
13 server/website software wherein there is no motivation for combination with
14 Kim's client/browser software; and, if combined, would result in a conflict
15 between Kim's browser which delivers ads not in response to user action and
16 How-To's ad prevention strategies. Additionally, How-To's strategies are server-
17 specific, and would not work (if they could somehow be incorporated) in a
18 browser, such as Kim's, which must be enabled to surf among many servers.
19 Accordingly, for these reasons and others, the references cited do not—singly or in
20 combination—disclose the elements recited in the Applicant's claims.

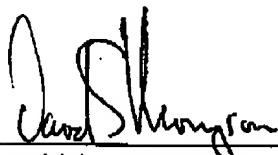
21 Accordingly, claims 1—15, 31—45, 61—75 and 91—109 are believed to
22 be in condition for allowance. Applicant respectfully requests reconsideration and
23 prompt issuance of the present application. Should any issue remain that prevents
24 immediate issuance of the application, the Examiner is encouraged to contact the
25 undersigned attorney to discuss the unresolved issue.

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Dated: 1-26-04


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